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09/784,394	02/15/2001	Marc Eller	12179-P081P1	2998

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EXAMINER

SALCE, JASON P

ART UNIT	PAPER NUMBER
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2623

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Art Unit: 2623



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/784,394
Filing Date: February 15, 2001
Appellant(s): ELLER ET AL.

Kelly K. Kordzik
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/15/2004 appealing from the Office action mailed 7/20/2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The parent application to this application, Serial No. 09/553,012, received a Decision on Appeal (2004-1516). The examiner further notes that the Decision was not included in the appendix as stated by the Appellant on page 18 of this Appeal Brief, therefore the examiner has provided a copy of the brief and is attached.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Carney et al. (U.S. Patent No. 6,408,278)

Rhoads (U.S. Patent No. 6,411,725)

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carney et al. (U.S. Patent No. 6,408,278) in view of Rhoads (U.S. Patent No. 6,411,725).

Referring to claim 14, Carney discloses providing a first electronic billboard at a first location (see element 14a in Figure 3 and Column 5, Lines 26-29).

Carney also discloses coupling a first information handling system to the first electronic billboard (see element 24a in Figure 3) so that the first information handling system can control information to be displayed on the first electronic billboard (Column 3, Lines 57-67).

Carney also discloses providing a second electronic billboard at a second location (see element 14n in Figure 3 and Column 5, Lines 26-29).

Carney also discloses coupling a second information handling system to the second electronic billboard (see element 24n in Figure 3) so that the second information handling system can control information to be displayed on the second electronic billboard (Column 3, Lines 57-67).

Carney also discloses coupling the first and second information handling systems to a third information handling system over a network (see element 20 in Figure 3 and Column 3, Line 6).

Carney also discloses selecting, via the third information handling system, which of the first and second electronic billboards will display the information (Column 3, Lines 55-67).

Carney also discloses uploading the information from the third information handling system (Column 3, Lines 59-63) over the Internet (Column 5, Lines 40-42) to the information handling system controlling the selected electronic billboard (Column 5, Lines 37-40).

Carney also discloses displaying the information on the selected electronic billboard (Column 3, Lines 65-67 and Column 5, Lines 26-29).

Carney discloses various types of networks for transmitting the video, but fails to disclose a digital television broadcast network. Rhoads discloses a digital television broadcast network for transmitting video to a billboard (see Column 12, Lines 44-56 and Column 19, Lines 26-30).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the network for transmitting video to the billboards, as taught by Carney, using the digital television broadcast network for transmitting video to billboards, as taught by Rhoads, for the purpose of providing higher quality television signals, which can be used to entice a user to view the billboard, as well as enable a system to use the existing cable system already deployed by the different cable companies, thereby minimizing the cost of the system.

Referring to claim 5, where Rhoads teaches a television transmitter for transmitting the billboard information to the billboard in a wireless manner (see Column 12, Line 47 for a satellite broadcast).

Claim 6 corresponds to claim 5, with the additional limitation of providing a multiplexer. Carney and Rhodes fail to disclose a multiplexer. The examiner takes

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Official notice that a multiplexer is well known in a satellite television distribution system. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the satellite broadcast system of Carney and Rhoads, to utilize a multiplexer, for the purpose of compacting various television signals provided from different broadcasters into one 6 Mhz channel for a more efficient transmission method.

Referring to claim 19, see rejection of claim 14.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 15-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carney et al. in view of Rhoads (U.S. Patent No. 6,411,725) in further view of Hunter (U.S. Patent No. 6,430,605).

Referring to claim 15, Carney and Rhoads teach all of the limitation in claim 14, but fails to teach a time period for displaying information on the billboard and displaying the information for the specified time period.

Hunter teaches selecting advertisements on a billboard at a selected time period (Column 8, Lines 57-67), and displaying an advertisements for the selected period of time (Column 9, Lines 15-18).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the server (third information handling system), as taught by Carney and Rhoads, using the option to specific a time period for displaying programming content, as taught by Hunter, for the purpose of alerting the users of "sale" items that are only available for a specified limited time (Column 2, Lines 47-52 of Hunter).

Referring to claim 16, Carney teaches all of the limitations in claim 14, but fails to teach the additional limitation of choosing the first and second billboard to receive information from a list of billboards.

Hunter teaches selecting which roadway-adjacent billboards to display programming content (Column 8, Lines 63-67).

At the time the invention was made, it would have been obvious to modify the server, as taught by Carney and Rhoads, using the option to allow the advertiser to choose which billboard to displaying information from a list, as taught by Hunter, for the purpose of allowing an advertise to only choose to display programming content where a high traffic volume is known (Column 2, Lines 25-30 of Hunter).

Claim 17 corresponds to claim 16, with the additional limitation of the list including a map of the first and second locations. Hunter teaches that a map can provide the location and directions to a company's local stores (Column 9, Lines 2-5).

Claim 18 corresponds to claim 16, with the additional limitation of charging an amount of money for the display of the information on the selected electronic billboard.

Hunter teaches a module 190 for producing bills for charging an advertiser (Column 5, Lines 32-34).

Referring to claim 20, see rejection of claim 15.

(10) Response to Argument

1. The provisional patent applications relied upon for priority support the claim limitation "digital television broadcast network".

As stated in the previous examiner's arguments, the examiner disagrees and will provide a breakdown of each provisional application and explain why the limitation "digital television broadcast network" is not met.

Provisional Application 60/130,602

On Page 5, Lines 14-16, the provisional application states, "The ads can be uploaded to the billboard system through a direct connection, locally, or remotely using landlines, cable, satellite signaling, fiber optic cable, wireless transmissions, etc." The provisional application also states on Page 5, Lines 8-10 that, "Electronic billboards, such as the one illustrated in FIGURE 2, have the capability of displaying still or video images in a manner similar to a television or a computer display." Nowhere does the provisional application provide support for a digital or analog television network. Digital and analog television broadcast networks are specific architectures that provides a vast majority of different services using two different methods. In order to further explain the difference between the two types of networks, the examiner has provided an Insight article to provide a clear explanation between the two types of

broadcast networks. In particular, Insight has provided an article entitled, "Basic, Classic and Digital Cable". In the Article, digital cable is explained as "Insight's Basic and Classic services are considered analog cable. Analog and digital are electrical terms referring to the two different transmission formats for electrical information". The article further explains that, "Analog cable has limited features, while digital cable has a clearer picture, more channels, and more advanced interactive services, like On Demand TV and the on-screen program guide". The examiner recognizes the different networks that can be used to transmit (uploading) data, but the examiner notes that these transmission networks do not even teach transmitting television signals, let alone digital or analog television signals. The only passage in the provisional application that states the term "television" is Page 5, Lines 8-10 (see above). This passage states that billboards can display video images in a manner similar to a television, but makes no teaching of how a television would actually receive the signal, only how a television would display a video image. Therefore, the provisional application provides no support for the claim limitation "digital television broadcast network".

Provisional Application 60/147,673

Although the provisional application provides more detail about the transmission means of the billboard system, the examiner notes that a "digital television broadcast network" is still not taught. Regarding Page 5, Lines 8-10 and Lines 14-16 see the arguments above regarding the provisional application 60/130,602 failing to teach a "digital television broadcast network". On Page 8, Lines 14-16 the provisional application teaches broadcasting data, but fails to teach a television network (neither

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analog or digital), the broadcast network described here simply discusses that the billboard is capable of broadcasting information to car radios (not a television network). On Page 8, Lines 19-20 and Page 9, Lines 3-5, the same networks are described to transmit data, but nowhere is a television network (neither analog or digital) described (see arguments regarding provisional application 60/130,602).

Applicant also argues that the examiner asserted that Carney disclosed a "digital television broadcast network". As previously stated in the previous Office Action, the examiner agreed, in view of the Applicant's arguments that Carney fails to teach a digital television broadcast network. However, the examiner provided Rhoads in order to provide a 103 rejection in support of the claim limitation "digital television broadcast network".

2. Claims 5-6, 14 and 19 are not properly rejected under 35 U.S.C. § 103 as being unpatentable over Carney in view of Rhoads.

Applicant argues that Carney's provisional application (60/107,735) does not support the claim limitations of the Carney patent. Carney's patent application filing date (11/10/1999) is before the filing date of the Applicant's filing date of 2/15/2001 and the CIP filing date of 04/20/2000. Since the applicant's provisional applications fail to support the claim limitations of the instant application, the examiner has not previously relied upon Carney's provisional application to provide a date before the Applicant's provisional applications.

However, the examiner has reviewed Carney's provisional application and disagrees. The provisional application of Carney clearly reads on the claim limitations rejected by the Carney patent in the Figures disclosed on pages 12 and 20 of Carney's provisional application, as well as various other pages of the provisional application's disclosure. Carney provides distributing information to electronic billboards from a push server (third information handling system) through the Internet.

Regarding claims 14 and 19, Applicant argues that Rhoads does not teach a digital television broadcast network for transmitting video. The examiner agrees that Rhoads does in fact teach encoding and decoding information in video objects in a video sequence, however, Rhoades also teaches that video streams can be transmitted over various types of networks (Column 12, Lines 41-52) and that the video signal can be compressed and comprise MPEG 4 video objects (see Column 7, Lines 59-67 and Column 8, Lines 1-3 and Column 12, Lines 52-56), which is a digital signal format transmitted over a cable or satellite broadcast (see again the Insight article under the section "What is digital cable?" for describing that digital cable uses digital technology to compress video signals). Rhoades goes on to teach that one of the display devices that can be used to display the video objects (with watermarks) is a virtual billboard. Therefore, Rhoades clearly teaches that a digital television broadcast network can be used to transmit digital cable signals to a billboard.

Applicant argues that since Rhoades refers to "virtual billboards", it actually implies that it does not teach or suggest such transmission of video to billboards, since with such virtual billboards, there are no physical billboards to transmit to. The

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examiner disagrees and notes that Applicant appears to be misinterpreting the term "virtual". In the computer science field, dictionary.com defines virtual as, "Created, simulated, or carried on by means of a computer or computer network". Therefore, display on a physical (virtual) billboard and reception of the video signal displayed on the physical (virtual) billboard is clearly being performed. Also note that Rhoades further teaches the use of billboards for displaying the received video signal (over the digital television transmission network) at Column 19, Lines 44-53, which teaches that, "Watermarks may be embedded in the images on large physical objects, such as outdoor signs...A typical example would be billboards inside a baseball park or football stadium. When a video is captured of these physical objects, the watermarked images on these objects is recorded in the video signal". Therefore, Rhoades teaches the limitation of a "digital television broadcast network" used to communicate information to electronic billboards.

Regarding claims 19 and 20, see the arguments above.

Regarding claim 5, see the arguments above.

Regarding claim 6, the Applicant has traversed the examiner use of Official Notice to teach a multiplexer for transmitting video to an electronic billboard. The examiner cites Honey et al. (U.S. Patent 5,917,553), which teaches transmitting a modified video signal to an electronic billboard (see Column 1, Lines 41-67 and Column 2, Lines 1-14 and Lines 56-63 and Column 5, Line 63 through Column 6, Line 67).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify system and digital television broadcast network, as

taught by Carney and Rhoads, using the multiplexer 206, as taught by Honey, for the purpose of allowing a producer of a live event to switch between the various broadcast cameras at the stadium and the television viewer will see the enhancement regardless of which camera is selected by the producer (see Column 2, Lines 66-67 and Column 3, Lines 1-2 of Honey).

3. Claims 15-18 and 20 are not properly rejected under 35 U.S.C. § 103 as being unpatentable over Carney in view of Rhoads and Hunter (U.S. Patent No. 6,430,605).

Applicant argues that Hunter does not constitute as prior art for the same reasons argued above regarding the provisional applications of the applicant's instant application, therefore, see the arguments above on how the instant application's provisional application do not provide proper support the claim limitations. The examiner notes that applicant does not argue the limitations taught by Hunter.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

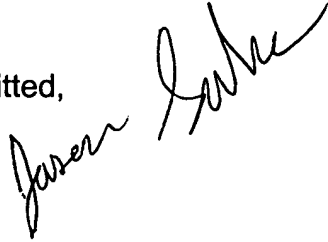
For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Jason Salce


August 24, 2006




Conferees:

John Miller

Chris Grant



JOHN MILLER
SUPERVISORY PATENT EXAMINER
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CHRIS KELLEY
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RK

The opinion in support of the decision being entered today was **not** written for publication in a law journal and is **not** binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARC ELLER AND ZVI YANIV

Appeal No. 2004-1516
Application No. 09/553,012

ON BRIEF

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before BARRETT, GROSS and NAPPI, **Administrative Patent Judges.**

NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 14, 16 through 25, 27 through 35, 37 through 41 and 55. For the reasons stated *infra* we affirm-in-part the examiner's rejection of these claims.

The Invention

The invention relates to a system for use with electronic billboards, whereby a user can access a web site to upload a desired advertisement to a server and select a billboard to display the advertisement. When the advertisement is approved, the

advertisement is then transmitted to the selected billboard to be displayed at the time requested by the user. (See page 3 of appellants' specification).

Claim 14 is representative of the invention and is reproduced below:

A method for displaying information on an electronic billboard, comprising the steps of:

providing a first electronic billboard at a first location;

coupling a first information handling system to the first electronic billboard so that the first information handling system can control information to be displayed on the first electronic billboard;

providing a second electronic billboard at a second location;

coupling a second information handling system to the second electronic billboard so that the second information handling system can control information to be displayed on the second electronic billboard;

coupling the first and second information handling systems to a third information handling system over the Internet;

selecting, via the third information handling system, which of the first and second electronic billboards will display the information;

uploading the information from the third information handling system over the Internet to the information handling system controlling the selected electronic billboard;

selecting, via the third information handling system, a time period for displaying the information on the selected electronic billboard; and

displaying the information on the selected electronic billboard during the selected time period.

References

Royal, Jr. et al. (Royal)	5,980,090	November 9, 1999 (filed February 10, 1998)
Adler et al. (Adler)	6,009,409	December 28, 1999 (filed April 2, 1997)

Appeal No. 2004-1516
Application No. 09/553,012

Rejections at Issue

Claims 14, 16 through 25, 27 through 35, 37 through 41 and 55 stand rejected under 35 U.S.C. § 103 as being unpatentable over Royal in view of Adler. The rejection is set forth on pages 3 through 12 of the answer.

Opinion

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs,¹ along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and examiner, for the reasons stated *infra*, we will sustain the examiner's rejection of claims 14, 16, 18, 19 through 21, 27, 28, 31, 32 and 37 through 39 under 35 U.S.C. § 103. However, we will not sustain the examiner's rejection of claims 17, 22 through 25, 29, 30, 33 through 35, 40, 41 and 55 under 35 U.S.C. § 103.

¹ This decision is based upon the Appeal Brief received November 17, 2003 (certified as being mailed on November 11, 2003, in accordance with 37 C.F.R. § 1.8(a)) and the Reply Brief received March 8, 2004 (certified as being mailed on March 4, 2004, in accordance with 37 C.F.R. § 1.8(a)).

Grouping of the Claims

At the outset, we note that appellants state on page 4 of the brief that, "claims 14, 16-25, 27-35, 37-41 and 55 are to be considered individually per the reasons set forth in section VIII."

37 C.F.R. § 1.192(c) (7) (July 1, 2003) as amended at 62 Fed. Reg. 53196 (October 10, 1997), which was controlling at the time of appellants' filing of the brief, states:

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and in the argument under paragraph (c) (8) of this section appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Accordingly, we will group the claims into 11 groups.

Group A consists of claims 14, 16, and 37 through 39 with claim 14 as the representative claim. (We note appellants' arguments do not directly address claim 16, and appellants' arguments, on page 12 of the brief, group claims 37 through 39 with claim 14).

Group B consists of claims 17, 22, 23 and 55, with claim 17 as the representative claim. (We note that appellants' arguments, on pages 7, 8, 10 and 13 of the brief, group claims 17, 22, 23 and 55).

Group C consists of claim 18.

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Group D consists of claims 19 through 21, with claim 19 as the representative claim. (We note that appellants' arguments, on pages 9 and 10 of the brief, group claims 19 through 21).

Group E consists of claims 24 and 25, with claim 24 as the representative claim. (We note that appellants' arguments, on page 10 of the brief, group claims 24 and 25).

Group F consists of claims 27, 28, 31 and 32, with claim 27 as the representative claim. (We note that appellants' arguments, on page 12 of the brief, do not address why dependent claims 28, 31 and 32 are separately patentable).

Group G consists of claims 29, and 30, with claim 29 as representative claim. (We note that appellants' arguments, on page 12 of the brief directed to claims 29 and 30 are the same).

Group H consists of claim 33.

Group I consists of claims 34 and 35, with claim 34 as the representative claim.

Group J consists of claim 40.

Group K consists of claim 41.

Appellants argue, on page 4 of the appeal brief, "the disclosure is not properly objected to for including embedded hyperlinks." Appellants further argue this issue on page 2 of the reply brief. This relates to a petitionable matter and is not an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review the issue raised by the appellants on page 4 of the brief and page 2 of the reply brief.

Rejection of Claims In Group A (Claims 14, 16, and 37 though 39).

Appellants argue on page 5 of the brief that the rejection of claim 14 is improper as Royal does not teach using the third information handling system to select the time period for displaying information on the selected billboard. Further, appellants argue that Adler "merely teaches that at least two advertisements may be allocated to be displayed on a single display device of a remote computer, so that the advertisements may be displayed at different times on that particular single remote computer." Thus, appellants conclude, "it is impossible for *Adler* to select a time period for displaying information on an electronic billboard that has been selected from at least two electronic billboards at separate locations." On page 6 of the brief, and page 2 of the reply brief, appellants assert that the examiner has provided no objective evidence of suggestion to combine Royal and Adler.

We are not convinced by appellants' arguments. We find that Royal's remote server and browser items 25 and 26, as modified by Adler, teach the claim 14 limitation of "selecting, via the third information handling system, a time period for displaying the information on the selected electronic billboard." Royal teaches that remote server and browser, items 25 and 26, can access any of the devices at a service station, we consider the remote server and browser to meet the claimed third information handling system. (See column 8, lines 7-11). The devices include a display, item 38 in figures 2 and 3. (See Column 4, lines 2-3 and 9-10). The data downloaded to these devices can include advertising information, which can include several commercials. (See column 8, line 59 and box titled "advertising interface" in figure 7b). Royal is silent as to any

sequence or timing of displaying the advertisements. We find that a skilled artisan in reviewing Royal's disclosure would recognize that the three advertisements couldn't be displayed concurrently and seek to employ some method of determining which advertisement to display at any given moment.

We find that Adler teaches a time allocation controller which controls the time allocated amongst advertisements displayed on a remote computer, (see column 2, lines 13-18) and that Adler provides the requisite suggestion to combine the references as asserted by the examiner. Our reviewing court has said "The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved." *In re Huston* 308 F.3d 1267, 1278, 64 USPQ2d 1801, 1810 (Fed. Cir. 2002, citing *In re Kotzab* 217 F.3d 1365, 1370, 55 USPQ 1313, 1317 (Fed. Cir. 200)). Adler states in column 1, lines 54 through 56 "what is needed in the art is a system and method for efficiently scheduling the display of advertisements in a communications network, such as the Internet." We find that the nature of the problem to be solved in Adler, to efficiently schedule advertisements, provides the motivation to modify a system such as Royal, which has no system to schedule advertisements. We find that one of ordinary skill in the art, implementing Adler's scheduling in Royal's system, would be motivated to implement it in Royal's remote server and browser items 25 and 26, as Adler's disclosure is directed to setting the scheduling remotely. As stated *supra*, we find that Royal's remote server and browser, items 25 and 26, meet appellants' claimed third information handling system. Thus, we find motivation to combine Royal and Adler, and

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that the combination teaches the selection of the time period for the advertisement is performed at the third information handling system. Accordingly, we sustain the examiner's rejection of claim 14 and the claims grouped with claim in group A, claims 16, and 37 through 39.

Rejection of Claims in Group B (Claims 17, 22, 23 and 55).

Appellants argue, on page 7 of the brief, that the rejection of the claim 17 is improper as Royal does not teach "a map that is displayed so that sites to which information is to be uploaded to can be selected from. Fig.7 merely shows an overview of a fueling site capable of being accessed by and communicating with a distributor."

The examiner states in response on page 15 of the answer:

Examiner disagrees with this situation because Royal teaches the backroom server 18 as a central control-type server capable of providing the client PC browsers 25, 27 with additional information relating to the equipment and providing links to available servers and other compliant devices in the fueling environment (col 7, lines 15-19). Royal also teaches information dissemination and advertising are preferably performed as services provided by the various local and remote servers. The browser software 36 for each client preferably has the ability to request services either locally or remotely, via the Internet or similar network.

We concur with the appellants. We fail to see the nexus between appellants' argument and the examiner's response. We find that Royal's disclosure does include a map, figure 7a, and we find that this map is a diagram to aid in explaining the invention. We find no teaching in Royal that the map is associated with a list of electronic billboards. Claim 17 includes the limitations of "selecting, via a third information handling system ... wherein the selected electronic billboard is selected from a list of

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available electronic billboards ... wherein the list includes a map of the first and second locations." Claims 22, 23 and 55 contain similar limitations. Accordingly, we will not sustain the examiner's rejection of claims 17, 22, 23 and 55.

Rejection of Claims In Group C (Claim 18).

Appellants state, on page 8 of the brief, that claim 18 includes the limitation of charging an amount of money for displaying the information on the selected billboard.

Appellants argue:

neither *Adler* or *Royal*, nor their combinations teaches or suggests charging an amount of money for the display of the information on the electronic billboard that is selected from the first and second electronic billboards to display information to be uploaded to the system, wherein the selected electronic billboard is selected from a list of available electronic billboards, which includes the first and second electronic billboards.

On page 15 of the answer, the examiner replies stating "[t]his argument is not persuasive because *Adler* reviews in the background of the invention [that it is known to] charge higher prices for advertising region (col. 1, line 45)."

We concur with the examiner and are similarly not convinced by appellants' arguments. As discussed *supra* with respect to claim 14, we find that the combination of *Royal* and *Adler* teach a system where a remote server can access any of a plurality of devices, which have displays, and that advertising material can be downloaded to these devices. Claim 18 also includes the limitation "charging an amount of money for the display of the information on the selected electronic billboard." *Royal* is silent as to fees being associated with displaying advertisements on the devices. As stated by the examiner, *Adler* teaches that charging for advertising based upon an individual location

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is known. We find that the skilled artisan would recognize that the advertisers should be charged for displaying their advertisements on Royal's system devices, given Adler's disclosure that charging for advertising space is well known. Accordingly, we sustain the examiner's rejection of claim 18.

Rejection of Claims in Group D (Claims 19 through 21).

Appellants argue, on pages 9 and 10 of the brief, that the rejection of claims 19 through 23 is improper as the examiner has not interpreted the claims in accordance with MPEP § 2181 and as is required by the decision in *In re Donaldson* 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994).

We note that the appellants have not specifically asserted that there are any limitations of either representative claim 19 or in claims 20 and 21, which are not taught by the reference applied by the examiner. Similarly, for the reasons stated *infra*, we do not find any limitation in representative claim 19, which is not taught by the references applied by the examiner. We also note that 37 CFR § 41.37(c)(1)(v)(2004) now requires that in the summary of the claimed subject matter section of the brief "every means plus function and step plus function as permitted by 35 U.S.C. § 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters." However, as 37 CFR § 41.37(c)(1)(v) was not in effect as of the appellants' filing of the brief, we provide the following analysis of the limitations in claim 19 and the corresponding structure in appellants' specification.

We find no corresponding structure in appellants' specification for the "means for providing a first electronic billboard at a first location." Appellants' specification identifies, on page 6, that the billboard is an electronic display item 200, however, we find no disclosure of structure to provide an electronic display. Our reviewing court has stated "if one employs means-plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." *In re Donaldson* 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850. In this case we find that the claim limitation is clear in that the means is any and all structure that provides an electronic display and a rejection under 35 U.S.C. § 112, second paragraph, is not warranted. Clearly, the gas pump, item 12, with an electronic display, item 38, of Royal's figure 3 meets the limitation of "means for providing a first electronic billboard." Through similar reasoning Royal also teaches the limitation of "providing a second electronic billboard."

We find no corresponding structure in appellants' specification for the "means for coupling a first information handling system to the first electronic billboard so that the first information handling system can control information to be displayed on the first electronic billboard." We find that appellants' specification identifies on page 6, that the information handling system is a processor, memory device, with information to be displayed stored therein, and associated drivers are all located with the billboard. However, appellants' specification discloses no structure to couple the processor,

memory and drivers to the billboard. Again, we find the claim clear in that the means is any and all structure that couples the electronic display to the processor. Thus, we find that the connection between controller, item 32 and display, item 38, in Royal's figure 2 meets the limitation of "means for coupling a first information handling system to the first electronic billboard." Through similar reasoning Royal also teaches the limitation of "means for coupling a second information handling system to the second electronic billboard."

We find the corresponding structure for the "means for selecting, via the third information handling system, which of the first and second electronic billboards will display the information" and "means for uploading the information from the third information handling system over the internet" is a website. Pages 7 and 8 of appellants' specification identifies that the client logs on to a website to select a billboard and to upload advertising material. The client's system, although not disclosed as such, is assumedly a computer with a browser, to log on to the website. Thus we find that the system which the client uses to log on to the web site is the third information handling system. We find that Royal's remote server and browser meet the limitation of the third information handling system and that Royal teaches that a browser is used to access a web page to select the display device and to update the advertising. (See column 7, lines 25 to 28, and figure 7b).

We find the corresponding structure for "coupling the first and second information handling systems to a third information handling system over the Internet"² to be a server operated by the billboard provider. Page 7 of appellants' specification identifies that a client communicates with a website and page 8 of appellants' specification identifies that "ebillboard.net" is a server operated by the billboard provider. We find that the local server (item 18) of Royal meets this limitation. Royal teaches that the display devices can be either directly accessed by the Internet or they can be accessed through the local server (see column 5 lines 53-56 and column 6, lines 4-6). Thus, we consider accessing the display of the dispensing device through the local server to meet the claim limitation of "coupling the first and second information handling systems to a third information handling system over the Internet."

We find no corresponding structure in appellants' specification for the "means for displaying the information on the selected electronic billboard." As stated *supra*, we find that appellants' specification identifies, on page 6, that the billboard is an electronic display item 200. However, we find no disclosure of structure for displaying information on the electronic display. In this case we find that the claim limitation is clear in that the means is any and all types of signals that produce a display of the information on the electronic display and a rejection under 35 U.S.C. § 112, second paragraph, is not warranted. Clearly, the output of Royal's controller, item 32, for the display, item 38,

² We note the copy of claim 19 in appendix A contains an error. Claim 19 in the official file (original) includes the limitation "means for coupling the first and second information handling system to a third information handling system over the Internet." The copy of claim 19 in appendix A includes the limitation "means for coupling the first and second information handling system to a third information handling system over a digital television broadcast network." There is no disclosure in the originally filed specification of using a digital television broadcast network. We review the examiner's rejection as it applies to claim 19 in the file and not as presented in appendix A.

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produce signals which produce a display of the information and meet the limitation of "means for displaying the information on the selected electronic billboard."

For the forgoing reasons, we sustain the examiner's rejection of claim 19 and the claims grouped with claim 19 in group D, claims 20 and 21.

Rejection of Claims in Group E (Claims 24 and 25).

Appellants argue on page 11 of the brief:

The Examiner asserts that the step of uploading additional information concerning the advertiser via the remote computer by the advertiser at the advertiser's option is disclosed in *Royal* as the uploading of commercials 1, 2, and 3. The problem with such an assertion by the Examiner is that it again divorces this claim limitation from the remainder of claim 24. Claim 24 further asserts that this optional additional information is transmitted from the ebillboard.net server to a web site dedicated to the selected billboard. In fact, the Examiner has ignored this transmitting step of claim 24.

The examiner states, in response on page 15 of the answer: "These arguments are not persuasive because *Royal* teaches a homepage at a site's uniform resource locator address (block100) (fig. 5, col. 7, lines 20-22)."

We are not convinced by the examiner's reasoning. Claim 24 contains the limitations of uploading advertising data and additional information concerning the advertiser. Claim 24 also contains the limitations of transmitting the advertising data to a billboard and transmitting the additional data to a web site dedicated to the billboard. We note that we interpret the term "ebillboard.net" in claim 24, as a name, or designator, associated with the claimed server and afford that the term itself does not limit the claim. We find that *Royal* teaches the step of transmitting the advertising information to the selected billboard, via a web site. However, we find no disclosure in

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to the billboard. Accordingly, we will not sustain the examiner's rejection of independent claim 24 or dependent claim 25.

Rejection of Claims in Group F (Claims 27, 28, 31 and 32).

Appellants assert, on page 12 of the brief, that claim 27 includes a limitation of sending the first information over a second network to the first designated target display, wherein the first information is accompanied with a time when the first information is to be displayed on the first designated target display and that the art relied upon in the examiner's rejection does not teach this limitation.

We are not convinced by appellants' arguments. As stated *supra* with respect to claim 14, we find that the combination of Royal and Adler teach sending advertisement information to a designated display along with a selected time period to display the advertisement. Further, we find that Royal teaches that the connection from the remote server can either directly communicate to the pump with the display through the Internet or can communicate through the local server (item 18). We find that this communication through the local server requires first loading the information from the remote server to the local server via the Internet and then downloading the information from the local server to the electronic display, thus teaching the claimed receiving over a first network and sending over a second network. Accordingly, we sustain the examiner's rejection of claim 27 and the claims grouped with claim 27 in group F, claims 28, 31 and 32.

Rejection of Claims in Group G (Claims 29, and 30).

Appellants argue, on page 12 of the brief, that the rejection of claim 29 is improper, as the art applied by the examiner does not show the sending step of 27 sends the first information over the Internet to the designated display.

We concur. As discussed *supra* with respect to independent claim 27, we find the embodiment of Royal where the local server is the intermediary between the remote server and the designated display. We find that Royal teaches that the Internet is used to connect the remote server to the local server or the displays in the embodiment where the remote server can directly access the displays and use the Internet to connect the remote server and the local server in the embodiment where the local server acts as an intermediary. However, in the embodiment where the local server is the intermediary, the embodiment that teaches the uploading and downloading limitations of independent claim 27, we do not find that Royal teaches or suggests that the Internet is used to provide the information from the local server, item 18, to the display, item 38. Accordingly, we will not sustain the examiner's rejection of claims 29 and 30.

Rejection of Claims in Groups H and I (Claims 33 through 35).

Appellants argue, on page 2 of the brief, that the rejection of claim 33 is improper, as the art applied by the examiner does not teach the second network of independent claim 27 is part of the Internet.

We concur for the reasons stated *supra* with respect to claims 29 and 30. Claims 34 and 35 are dependent on claim 33. Accordingly, we will not sustain the examiner's rejection of claims 33 through 35.

Rejection of Claims in Group J (Claim 40).

Appellants argue, on pages 12 and 13 of the brief, that the combination of Adler and Royal do not teach: "the steps of outputting information on whether the target display device is available to display the content, permitting a selection of the target display device if it is available to display the content, and preventing a selection of the target display device if it is not available to display the content."

The examiner states in response, on page 17 of the answer:

Royal teaches a system (figure 2) associated with a computer readable medium, a system comprising a target display 38 (fig. 2), a information, a content (commercial, fig. 7B), whether the target display device is available to display the content, permitting a selection of the target display device if it is available to display the content, and preventing a selection of the target display device if it is not available to display the content (user selects device from the list of possible devices on site network (block 108, fig. 5, col.7, lines 34-37).

We disagree with the examiner. We find that Royal teaches that the system can access the display device as stated *supra* with respect to claim 14. However, we find no disclosure in either Royal or Adler of a step that prevents the selection of the target display if it is not available. While such a step seems intuitive, we find that the evidence of record lacks such a teaching. Accordingly, we will not sustain the examiner's rejection of claim 40.

Rejection of Claims In Group J (Claim 41).

Appellants argue on page 13 of the brief:

the Examiner is attempting to reject all 3 steps recited in claim 41 with the mere teaching in *Adler* that as advertisements arrive, a decision must be made as to whether or not to include the advertisement in the schedule of T time slots. However, this does not teach or suggest outputting information on data and time availability of the target display device to display the content. It also does not teach or suggest permitting a selection of the target display device at a selected data and time if the target display device is available to display the content at the selected date and time. It also does not teach or suggest preventing a selection....

On pages 17 and 18 of the answer, the examiner responds to this argument reiterating his arguments with respect to claim 40 and stating "Royal teaches the sales information (block 306) (fig. 7B) having a date 3/14/97 inherently including an expired time of the items on sale. Adler also teaches a schedule for advertisements (see abstract)."

We are not convinced by the examiner's reasoning. While the sections of the references cited by the examiner do address scheduling of advertisements, we do not find that they teach the specific step claimed, outputting information of time and data availability, permitting and preventing selection based upon the information of date and time. Accordingly, we will not sustain the examiner's rejection of claim 41.

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief or by filing a reply brief have not been considered and are deemed waived by appellants [see 37 CFR § 1.192(a)]. Support for this rule has been demonstrated by our

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